

Remarks

I. Prosecution History and the Preamble

This case has been pending for nearly ten years. A first Office Action was mailed by Examiner Burgess on December 14, 2004, five and one-half years ago. After applicants responded, a Restriction Requirement was mailed by Examiner Burgess on May 31, 2005. After applicants responded to the Restriction Requirement, a second non-final Office Action was mailed by Examiner Burgess on September 20, 2005. After applicants responded to the second non-final Office Action, a third non-final Office Action was mailed by Examiner Burgess on March 28, 2006. After applicants responded to the third non-final Office Action, a fourth non-final Office Action was mailed by Examiner Burgess on August 10, 2006. After applicants responded to the fourth non-final Office Action, a fifth non-final Office Action was mailed by Examiner Burgess on March 20, 2007. That fifth non-final Office Action relied on a provisional application that Examiner Burgess did not provide to applicants, and applicants filed a response without the benefit of seeing the provisional application and then filed a supplemental response after obtaining a copy of the provisional application. Examiner Burgess then mailed a Final Rejection on September 20, 2007.

Applicants filed an Appeal Brief on January 31, 2008. Examiner Burgess reopened prosecution May 2, 2008, with a new Office Action that was very similar to the Final Rejection. A Request for Reinstatement of Appeal and a Supplemental Appeal Brief were filed July 30, 2008. A Notification of Non-Compliant Appeal Brief was mailed April 8, 2009. A Revised Appeal Brief was filed by applicants on April 8, 2009. Examiner Burgess again reopened prosecution with an Office Action mailed July 15, 2009. The Office Action once again failed to present a *prima facie* rejection, for at least one of the reasons addressed in the Revised Appeal Brief, which the Examiner failed to Answer. As noted on page 7 of that Revised Appeal Brief, the prior Final Rejection had stated that "the preamble of claim 1 was not being accorded any patentable weight." Curiously, the Examiner had also provided a reference that she said taught "the storage unit including a disk drive," which was the limitation that the Examiner had said "was not

being accorded any patentable weight.” The Examiner now argues, on pages 10 and 11 of the latest Final Rejection that:

(b) In response to applicant's arguments, the recitation "storage unit including a disk drive" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150,152, 88 USPQ 478, 481 (CCPA 1951).

Applicants respectfully disagree, for all the reasons noted in their prior Revised Appeal Brief that the Examiner failed to Answer. In addition, the cases cited by the Examiner do not support her position. In *Hirao*, the C.C.P.A. held that the contested claim was *nonobvious*, because the Board had failed to accord patentable weight to some limitations, and so failed to consider “the subject matter of the invention as a whole.” *In re Hirao*, 535 F.2d at 69-70. The Solicitor in that case had argued that the claim’s preamble indicated the subject matter of the claim was old, but the C.C.P.A. found that “(t)he Solicitor’s interpretation of the preamble would improperly broaden the scope of the claim.” *Id.* at 70. Thus, *Hirao* is actually contrary to the Examiner’s position. *Kropa v. Robie*, which was cited by *Hirao*, is similar. In that case, the Board had not accorded patentable weight to the word “abrasive” in the preamble, but the Court reversed, stating that “the words ‘An abrasive article’ are essential to point out the invention.” *Kropa v. Robie & Mahlman*, 187 F.2d at 152.

Moreover, although applicants do not necessarily agree with all that is stated in the MPEP, a glance at § 2111.02 “Effect of Preamble [R-3] - 2100 Patentability,” makes clear that the Examiner is in error in her failure to accord patentable weight to the preamble. For example, part I of § 2111.02 states: “Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).” Plainly, the recitation in the pending claims’ preamble of “the storage unit including a disk drive” limits the structure of the storage unit and thereby limits the claims. As another example, part II of § 2111.02 cites

Catalina Mktg. Int'l v. Coolsavings.com, Inc., 289 F.3d at 808-09, 62 USPQ2d at 1785 (which is also cited in the introduction to § 2111.02) for the rule that “clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention.” The limitation of “the storage unit including a disk drive” was added in an Amendment dated March 11, 2005, and so was introduced during prosecution and has been clearly relied upon during prosecution for over five years.

Further, as noted in applicants’ most recent Appeal Brief, *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 952 (Fed. Cir. 2006), which looked to the antecedent basis provided by the preamble to find that it was a limitation, states:

If the body of the claim “sets out the complete invention,” the preamble is not ordinarily treated as limiting the scope of the claim. *Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304, 1310 (Fed. Cir. 2002). However, the preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005), cert. denied, 126 S. Ct. 1174, 163 L. Ed. 2d 1141, 74 U.S.L.W. 3421 (U.S. Jan. 23, 2006); *SanDisk Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278, 1284 n.2 (Fed. Cir. 2005), cert. denied, 126 S. Ct. 829, 163 L. Ed. 2d 707 (2005). That is, if the claim drafter “chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.” *Bell Communications Research v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995) (emphasis in original). Moreover, when the limitations in the body of the claim “rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.” *Eaton Corp. v. Rockwell Int'l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003).

Because the preamble of claim 1 recites “a storage unit, the storage unit including a disk drive,” which provides antecedent basis for the limitation of “the storage unit” in the body of claim 1, the preamble should be considered a limitation. As further stated in *Bicon* at 950:

The purpose of a patent claim is to define the precise scope of a claimed invention, thereby “giv[ing] notice both to the examiner at the U.S. Patent and Trademark Office during prosecution, and to the public at large, including potential competitors, after the patent has issued.” *Johnson & Johnston Assocs. Inc. v. R.E. Serv. Co.*, 285 F.3d 1046, 1052

(Fed. Cir. 2002) (*en banc*). Allowing a patentee to argue that physical structures and characteristics specifically described in a claim are merely superfluous would render the scope of the patent ambiguous, leaving examiners and the public to guess about which claim language the drafter deems necessary to his claimed invention and which language is merely superfluous, nonlimiting elaboration. For that reason, claims are interpreted with an eye toward giving effect to all terms in the claim.

Thus, for all the foregoing reasons, including the cases cited by the Examiner, applicants respectfully submit that the Final Rejection is in error by failing to accord the preamble of the pending claims any patentable weight.

Applicants note that in their Reply of December 14, 2009, many other reasons were provided why the Examiner yet again failed to present a *prima facie* rejection, but those reasons will not be reiterated at this time. However, should applicants be forced to incur the time and expense of filing yet another Appeal Brief in this case, a Petition to the Director will also be filed seeking to preclude the Examiner from yet again reopening prosecution. Should that approach fail to prevent the Examiner from continuing the tortured prosecution of this application, applicants will have no choice but to seek redress in the District Court.

II. Conclusion

As detailed above and in applicants' prior Reply, the latest Final Rejection yet again fails to state a *prima facie* case of anticipation or obviousness for any of the pending claims. Appellants respectfully assert that all the pending claims are allowable and solicit a Notice of Allowance.

Respectfully submitted,

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